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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,196	12/27/2000	Yumiko Ouchi	045070-5032	2964

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EXAMINER

FINEMAN, LEE A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/748,196	OUCHI, YUMIKO	
	Examiner	Art Unit	
	Lee Fineman	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☒ Claim(s) 6, 10-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 08 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office Action is in response to an amendment filed 11 April 2003 in paper number 13 in which claims 1-2, 5-6 and 11-12 were amended and claims 15-17 were added and claims 4 and 7-9 were cancelled. Claims 1-3, 5-6 and 10-17 are pending.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Osa et al., PCT No. WO99/12068.

Regarding claim 1, Osa et al. discloses a stereomicroscope (fig. 6) comprising an illumination unit (LH) for illuminating a specimen (S) with light, a specimen setting board (not numbered, fig. 30), a fitting member (T) for fitting an objective lens (31), the illumination unit, specimen setting board and fitting member are disposed in sequence on an optical axis (fig. 30), wherein one of a predetermined low-magnification objective lens and a higher-magnification objective lens than the low-magnification objective lens is selected and fitted as the objective lens to the fitting member, the illumination unit includes a light source (20), a shield element (40a, 40b) for cutting off partially light beam emitted from the light source, first and second condenser lenses for converging the light beam passing the shield element on the specimen and a mechanism for selecting one of the first and second condenser lenses and disposing the selected condenser lens on the optical axis (26), the first condenser lens (fig. 35B) exhibits an optical

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characteristic of setting a position conjugate to an entrance pupil (P1, fig. 35B) of the low-magnification objective lens fitted to the fitting member in a position of the shield element (74a, 74b) or in the vicinity of the shield element and the second condenser lens (fig. 35A) exhibits an optical characteristic of setting a position conjugate to an entrance pupil (P1, fig. 35A) of the high-magnification objective lens fitted to the fitting member in a position of the shield element or in the vicinity of the shield element wherein the position conjugate to the entrance pupil of the low-magnification objective lens formed by the first condenser lens and the position conjugate to the entrance pupil of the higher-magnification objective lens formed by said second condenser are substantially same (figs. 35A and 35B) wherein the shield element is disposed at a position distant from the first and second condenser lenses (in so far as the shield is positioned at a distance from at least one of the condenser lenses, e.g. the lens r3r4, in each figure) and at a side of the light source (fig. 30).

Regarding claim 2, Osa et al. further discloses a first condenser lens for converging the light beam passing the shield element on the specimen and a mechanism for moving the first condenser lenses on and off the optical axis (26), the shield element is disposed in a position of an entrance pupil or in the vicinity of the entrance pupil of the high-magnification objective lens as the objective lens fitted to the fitting member and the first condenser lens exhibits an optical characteristic of setting a position conjugate to an entrance pupil of the low-magnification objective lens fitted to the fitting member in a position of the shield element or in the vicinity of the shield element (figs. 35A and 35B).

Regarding claim 5, Osa et al. further discloses a deflecting element for bending the optical axis (430, fig 39A) wherein the shield element (435) is disposed on the deflecting

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element and the shield element has a cover member for covering a part of a deflecting surface of the deflecting element.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osa et al.

Regarding claim 3, Osa et al. further discloses a zoom-stereomicroscope where the shield element is disposed in a position conjugate to the entrance pupil or in the vicinity of the entrance pupil of the objective lens exhibits the lowest magnification (figs. 36 and 37) but the reference does not explicitly state a zoom lens including a movable lens movable in a direction of the optical axis in order to change a magnification. Official notice is taken that it is well known to one of ordinary skill in the art at the time the invention was made that a conventional zoom system includes a zoom lens with a movable lens movable in a direction of the optical axis in order to change a magnification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention that the zoom-stereomicroscope of Osa et al. includes a zoom lens with a movable lens movable in a direction of the optical axis in order to change a magnification in that this system is readily available and can be easily obtained for use in manufacturing.

***Allowable Subject Matter***

5. Claims 6 and 10-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

Claim 6 is allowable over the prior art for at least the reason that the prior art fails to teach and/or suggest “the shield element including a mechanism for increasing and decreasing a covered area of the deflecting surface by feeding out and drawing in the cover member above the deflective surface in order to adjust a quantity of the light beam to be cut off” as set forth in the claimed combination.

Osa et al. discloses a deflecting element for bending the optical axis (430, fig 39A) wherein the shield element (435) is disposed on the deflecting element and the shield element has a cover member for covering a part of a deflecting surface of the deflecting element but does not have the cover member increasing or decreasing the covered area by a feeding-out or drawing-in mechanism as claimed.

Claims 10 and 13-15 are allowable over the prior art for at least the reason that the prior art fails to teach and/or suggest “where a reflectance of the front end portion of the cover member is larger than the reflectance of other portions thereof” as set forth in the claimed combination.

Osa et al. discloses deflecting element for bending the optical axis (430, fig 39A) wherein the shield element (435) is disposed on the deflecting element and the shield element has a cover

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member for covering a part a deflecting surface of the deflecting but does not have the cover member having portions wherein the reflectance of the front end portion of the cover member is larger than the reflectance of other portions thereof as claimed.

Claims 11-12 and 16-17 are allowable over the prior art for at least the reason that the prior art fails to teach and/or suggest the conditions for focal lengths and distances as set forth in the claimed combination.

Osa et al. discloses a stereomicroscope (fig. 6) comprising an illumination unit (LH) for illuminating a specimen (S) with light, a specimen setting board (not numbered, fig. 30), a fitting member (T) for fitting an objective lens (31), the illumination unit, specimen setting board and fitting member are disposed in sequence on an optical axis (fig. 30), wherein one of a predetermined low-magnification objective lens and a higher-magnification objective lens than the low-magnification objective lens is selected and fitted as the objective lens to the fitting member, the illumination unit includes a light source (20), a shield element (40a, 40b) for cutting off partially light beam emitted from the light source, and a first and second condenser lenses for converging the light beam passing the shield element on the specimen but does not satisfy the conditions for focal lengths and distances as claimed.

### ***Response to Arguments***

7. Applicant's arguments filed 14 April 2003 have been fully considered but they are not persuasive.

Regarding claims 1-2, applicant argues that Osa does not have the shield element disposed at a position distant from the first and second condenser lenses and that instead the

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shield element is within the condenser lens. The examiner respectfully disagrees. Applicant has used open-ended language in the claim; thus, reliance upon the Osa reference is appropriate since this reference includes a number of condenser lenses, e.g. lens r3r4, that are positioned at a distance from the shield element (74a or 74b) in figs. 35A and 35B.

Regarding claim 3, applicant argues that in the instant invention as recited in claim 3, a single shield element is used for both high and low magnification versus four shield members in Osa et al. The examiner respectfully disagrees. Applicant has used open-ended language in the claim; thus, reliance upon the Osa reference is appropriate since this reference includes a shield element.

Regarding claim 5, applicant argues that Osa et al. does not teach a shield member disposed on a deflecting element. The examiner respectfully disagrees. In fig. 39A, Osa et al. disclose a deflecting element for bending the optical axis (430) wherein the shield element (435) is disposed on the deflecting element and the shield element has a cover member for covering a part of a deflecting surface of the deflecting element.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period



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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF  
June 30, 2003

  
**MARK A. ROBINSON**  
**PRIMARY EXAMINER**